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10/059,145

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKAYUKI SUZUKI,
MAKOTO TOMIOKA, YUMI IKEDA, AKIRA HASEGAWA,
MITSUJIRO KONNO, and SHINYA MATSUMOTO

Appeal 2008-2628
Application 10/059,145
Technology Center 2600

Decided: August 22, 2008

Before JOSEPH F. RUGGIERO, SCOTT R. BOALICK,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 54-58, 61-65, and 68-70. An oral hearing on this appeal was

conducted on August 12, 2008. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants' invention relates to a TV observation system for an endoscope which includes a small-sized light source unit, and a TV camera removably mounted to the eyepiece section of the endoscope body. The TV camera, which includes an image pickup element, is optically attached to the eyepiece section of the endoscope to receive an optical image through the eyepiece section. (Spec. 4-6).

Claim 54 is illustrative of the invention and reads as follows:

54. A TV observation system for an endoscope, comprising:
an endoscope;
a TV camera; and
a light source,

wherein the endoscope has an insertion part having a thin and long shape, a holding part continuously extending from a proximal end of the insertion part, an eyepiece section formed on the holding part, a light guide that introduces illumination to a distal end of the insertion part, a light source connecting section formed on the holding part to achieve removable connection of the light source,

wherein the TV camera has an image pickup element and said TV camera is optically connected to the eyepiece section of the endoscope to receive an optical image through said eyepiece section, and

wherein the light source comprises a plurality of LEDs, said light source is removably connected to the light source connecting section, and the light source supplies illumination light to the light guide of the endoscope.

The Examiner relies on the following prior art reference to show unpatentability:

Hiyama	US 5,436,655	Jul. 15, 1995
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Claims 54, 55, 57, 58, 61, 63-65, and 68-70 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hiyama.

Claims 56 and 62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiyama.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C § 102(b), does Hiyama have a disclosure which anticipates the invention set forth in claims 54, 55, 57, 58, 61, 63-65, and 68-70?
- (ii) Under 35 U.S.C § 103(a), with respect to appealed claims 56 and 62, would one of ordinary skill in the art at the time of the invention have found it obvious to modify Hiyama to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)). “Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears

the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“...there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(b) REJECTION

With respect to the 35 U.S.C. § 102(b) rejection of independent claims 54, 61, and 68 based on the teachings of Hiyama, the Examiner indicates (Ans. 3-4) how the various limitations are read on the disclosure of Hiyama. In particular, the Examiner directs attention to the illustrations in various figures of the drawings in Hiyama, in particular, Figure 13, the accompanying description of which begins at column 20, line 19 of Hiyama.

Appellants’ arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Hiyama so as to establish a *prima facie* case of anticipation. According to Appellants (App. Br. 7-12; Reply Br. 4-7), the Hiyama reference provides no disclosure of an endoscope with an eyepieces section, let alone any disclosure of a TV camera which is optically connected to the eyepiece

section, features which are present in each of the appealed independent claims 54, 61, and 68.

After reviewing the Hiyama reference in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Briefs. Our interpretation of the disclosure of Hiyama coincides with that of Appellants, i.e., the element 235 in Hiyama, identified by the Examiner (Ans. 3) as corresponding to the claimed eyepiece, is simply a signal connector which functions to transmit the electronic signal from CCD element 232 to processing circuit 237. We can find no basis in the disclosure of Hiyama to support the Examiner's conclusion that signal connector 235, or any other disclosed structure in Hiyama, would correspond to an eyepiece, i.e., an element which enables observation of an image formed by the objective lens of the endoscope.

Further, in addition to Hiyama's lack of any disclosure of an endoscope with an eyepiece as discussed *supra*, we also agree with Appellants (App. Br. 8-10; Reply Br. 4-5) that Hiyama also lacks any disclosure of a TV camera which is optically connected to the eyepiece of an endoscope. We do recognize that Hiyama, at column 75, lines 1-5 referenced by the Examiner, suggests that a TV camera may be included in an optical endoscope structure. We find, however, no teaching or suggestion as to where on such a structure the TV camera would be located, let alone as having an optical connection to the eyepiece of the endoscope as specifically set forth in appealed independent claims 54, 61, and 68.

We also agree with Appellants (App. Br. 10, 11, 16, 17, and 20) that Hiyama does not disclose plural LEDs as the light source which supplies illumination light to the light guide of the endoscope, a feature present in

each of the independent claims 54, 61, and 68. While Hiyama does disclose the use of an LED element (255, Figures 19 and 25) and plural light emitting elements (Figure 37) as a light source, it is apparent from the disclosure of Hiyama (col. 26, ll. 39-44 and col. 38, ll. 16-19) that these light sources supply measuring light, not illuminating light as claimed. In fact, illuminating light is specifically disclosed by Hiyama as being provided by a lamp (element 247, Figures 19 and 25 and element 321, Figure 37).

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Hiyama, we do not sustain the Examiner's 35 U.S.C. § 102(b) rejection of appealed independent claims 54, 61, and 68, nor of claims 55, 57, 58, 63-65, 69, and 70 dependent thereon.

35 U.S.C. § 103(a) REJECTION

We also do not sustain the Examiner's obviousness rejection of dependent claims 56 and 62 based on the teachings of Hiyama. In addressing the requirements of claims 56 and 62, the Examiner has asserted (Ans. 4) the obviousness to the skilled artisan of supplying battery power to the endoscope light source in Hiyama. For all of the previously discussed reasons, however, regardless of the merits of the Examiner's stated position with respect to the claimed battery power feature, Hiyama lacks any disclosure of a TV camera optically connected to the eyepiece of an endoscope as set forth in independent claims 54 and 61, the respective base claims of rejected dependent claims 56 and 62.

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CONCLUSION

In summary, we have not sustained either of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 54-58, 61-65, and 68-70 is reversed.

REVERSED

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